

REMARKS

In the present amendment, claims 7, 11, 13, and 14 have been amended and claims 1-6, 8-10, 12, and 15 have been canceled and new claims 16 and 17 have been added. Accordingly, claims 7, 11, 13, 14, 16, and 17 are pending in the application, with claim 7 being the independent claim.

Applicants emphasize that the cancellation of claims 1-6, 8-10, 12, and 15 is without prejudice or disclaimer, and Applicants expressly reserve the right to prosecute these claims in their original, unamended form in one or more continuation and/or divisional applications.

Applicants note that the amendment of the claims and the addition of new claims are supported by the originally filed specification. No new matter has been added.

Claim of Priority

The Office Action did not acknowledge the claim of priority to Japanese Application No. JP2003-332084, filed September 24, 2003. Applicants respectfully request that the Office acknowledge the claim of priority in the next communication from the U.S. Patent and Trademark Office.

Response to Rejection under 35 U.S.C. § 112, second paragraph

The Office Action rejects claims 1-14 under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete, asserting that the claims “fail to provide adequate structural properties to allow for one to identify what is being claimed.”

As a preliminary matter, Applicants note that in order to advance prosecution of the application, and without expressing agreement with or acquiescence to the rejections, claims 1-6, 8-10, 12, and 15 have been canceled. Accordingly, Applicants address hereafter only the indefiniteness rejections of the pending claims 7, 11, 13, and 14.

The Examiner specifically asserts that claims 1-14 are rejected because “the methods as claimed only recite measuring Lipocalin-type prostaglandin D synthase (L-PGDS), but does not provide a correlation step or indicate what levels would detect pregnancy-induced hypertension.” In response, Applicants note that amended independent claim 7 provides a correlation step and indicates what levels would predict pregnancy

induced hypertension. Support for the amendment can be found in the original specification, e.g., page 11, line 19 – page 13, line 18.

Concerning claim 7, the Action alleges that the term “normal pregnant woman” is vague and indefinite, and requests that the term needs to be clarified. In response, Applicants note that the term “normal pregnant woman” in claim 7 has been amended by the additional description “not exhibiting symptoms of hypertension, proteinuria, and edema and not thought to be clinically affected with PIH.”

The Office further asserts that the metes and bounds of the “immunological assay method” in claims 11, 13, and 14 are not clear, asking, “which in particular are Applicants referring to?” In response, Applicants respectfully submit that the fact that there are many immunological assay methods does not, without more, render the claim indefinite – breadth is not indefiniteness. Nevertheless, solely in an effort to advance prosecution, Applicants note that claim 11 has been amended by adding the phrase “selected from the group consisting of an enzyme immunoassay method, a radio-immunoassay method, a latex agglutination assay method, and a fluorescence immunoassay method” to better define the claimed immunological assay method. The amendment of claim 11 also affects claims 13 and 14, since these are dependent claims of claim 11. Support for the amendment can be found in the present specification, e.g., on page 9, lines 1-8.

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the indefiniteness rejections.

Response to Enablement Rejections under 35 U.S.C. § 112, first paragraph

The Office Action rejects claims 1-14 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Action asserts that the disclosure “does not teach a particular method that would detect pregnancy-induced hypertension as opposed to other onsets of hypertension.” Moreover, the Office alleges that the specification is not enabling for a method of “evaluating a fetus and a placental function,” because it is not clear how the level of L-PGDS in a body fluid sample from a pregnant woman can be used to evaluate a fetus and a placental function.

Applicants respectfully note that the presently claimed invention is directed to a method of predicting pregnancy-induced hypertension. The specification as filed

discloses the method of predicting pregnancy-induced hypertension from page 11, line 19 to page 13, line 18. Furthermore, Examples 5 to 8 of the specification demonstrate the method for predicting pregnancy-induced hypertension. Also, the claims have been amended to even further clarify the claimed invention.

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the enablement rejections.

Response to Rejection under 35 U.S.C. § 102(b)

The Office Action rejects claim 15 under 35 U.S.C. § 102(b) as allegedly anticipated by Oda et al. (Clinical Chemistry, 2002, Vol. 48, pp. 1445-1453) or Melegos et al. (Clinical Chemistry, 1996, Vol. 42, pp. 1984-1991).

Applicants note that claim 15 has been canceled, rendering this rejection moot.

Response to Rejection under 35 U.S.C. § 103

The Office Action rejects claims 1-15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirawa et al. (Hypertension 2002, Vol. 39, pp. 449-454), in view of Edelstam, et al. (Scand J. Clin Lab Invest 2001, Vol. 61, pp. 583-591) and Oda et al. (U.S. Patent No. 6,461,827).

The Examiner refers to Hirawa et al. as disclosing that hypertensive persons, regardless of the source of the hypertension, have increased L-PGDS concentrations in the serum and urine. The Examiner further describes Edelstam et al. as teaching the importance of employing “a reference value in pregnant conditions to delineate a cut off value for determining a specific marker.” Finally, the Examiner asserts that Oda et al. discloses the same method of detecting L-PGDS, but admits, “Oda et al. do not teach the method of detecting L-PGDS in samples from individuals with pregnancy-induced hypertension.” The Examiner concludes that it would be obvious to combine the teaching of Hirawa et al. with the disclosure of Edelstam et al. and Oda et al. to arrive at the presently claimed invention.

Applicants respectfully note that present claims 7, 11, 13, and 14 are directed to a method of predicting pregnancy-induced hypertension. In contrast, Hirawa et al. describes investigations on persons already having hypertension and observes the concentrations of L-PGDS in the serum and urine compared to “normal” persons. Following the teaching in

Hirawa et al., a person of ordinary skill in the art would not be guided or motivated to develop a method of predicting the onset of hypertension. For example, Hirawa et al. concludes that "this increase probably reflects injuries in the renal tubes and arterioles induced by hypertension" (see page 453, left column, last paragraph), suggesting that hypertension induces injuries in the renal tubules and arterioles and then raises the L-PGDS levels. Thus, based on Hirawa et al., one would expect that elevated L-PGDS levels would only exist in someone who already was exhibiting hypertension.

Edelstam et al., which merely teaches the importance of reference values for routine blood samples, does not remedy the deficiency of Hirawa et al.

Oda et al., which teaches the technique to measure urinary L-PGDS levels by ELISA, also does not remedy the deficiency of Hirawa et al. or the deficiency of the combination of Hirawa et al. and Edelstam et al.

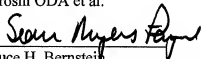
In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the obviousness rejections.

CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the restriction requirement and rejections of record and allowance of the pending claims.

Allowance of the application with an early mailing date of the Notice of Allowance and Allowability is therefore respectfully requested. If there are any further comments or questions, the Examiner is invited to call the undersigned at the telephone number indicated below.

Respectfully submitted,
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January 11, 2008
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